

176



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,627	12/17/1999	MING-LING LO	YO999-429	1398
7590 08/20/2004			EXAMINER	
ANNE E BARSCHALL 80 BENEDICT AVENUE TARRYTOWN, NY 10591			NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/466,627	Applicant(s) LO ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☒ Other: See Continuation Sheet


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

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Continuation of 10. Other:

It is respectfully noted that the examiner's rejections in the First Office action rely on the Turau reference, said rejections maintained thereafter using the same primary reference. It is respectfully submitted that Applicant gives no compelling reason why this affidavit wider 37 CFR 1.131 (hereinafter the affidavit) could not have been presented earlier in the prosecution history.

For the purpose of compact prosecution, a cursory review of the affidavit reveals at least the following possible issues:

The affidavit(s) in question does not appear to be signed by all named inventors of the application. Although it is possible for an affidavit to be accepted by less than all named inventors, nevertheless, there appears to be no submission of declaration under 37 CFR 1.47, etc. (see MPEP 715.04 item C).

The examiner notes "Declaration of Shyli-Kwei Chen, P.H.D." (with accompanying exhibits A-D) filed June 17, 2004. However, paper titled "Declarations Under C.F.R. 1.131" (filed on the same date as above), appears to be a letter submitted by Applicant's representative (Anne Barschall) mentioning another affidavit/declaration(s).

The affidavit(s) in question do not appear to indicate any reference to NAFTA or WTO (see MPEP 715.07(c)).

The examiner also notes paper "Declarations of Jen-Yao Chung, P.H.D." filed June 17, 2004 (with accompanying exhibits A-E). However, since said paper states Dr. Chung was a manager/supervisor of the inventors, Dr. Chung's Declaration appears insufficient because Dr. Chung is not listed as an inventor of Applicant's invention.

Applicant allegedly declares conception of the invention during summer of 1998, and worked part/full time up to reduction to practice during 1999. However, there does not appear to be a mapping of the evidence to claimed limitations for describing said invention. In addition, it appears unclear from the exhibits whether Applicant practiced due diligence up to final reduction to practice (see MPEP 1715.07). For example, exhibit C purports to show a listing of Applicant's relevant files and dates of modification. However, it appears unclear what these files are, other than the titles and extensions shown.

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